

Remarks

Reconsideration of the application is respectfully requested. Claims 1-20 are pending.

Applicant's arguments presented below focus on certain patentable differences between the invention as claimed and the applied references. However, it is not to be inferred that the failure to argue all differences between the claimed subject matter and the applied references constitutes acceptance of assertions made in the Office Action of alleged similarities between elements of the claimed subject matter and the applied references.

Claim Rejection - 35 U.S.C. §102:

Claims 1, 4, 8, 9, 11, 13-15 and 18-20 were rejected under 35 U.S.C. §102 as being anticipated by Michael (U.S. 2004/0170263). This rejection is respectfully traversed.

MPEP §2129 states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631,2 USPQ2d 1051,1053 (Fed. Cir.1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226,1236,9 USPQ2d 1913,1920 (Fed. Cir.1989).

Claim 1:

Claim 1 is directed to a method for providing presence state information. First messages are received by a presence server from at least two switches in the public switched telephone network (PSTN) containing call event information for consumer premises equipment (CPE) supported by telephone lines served by the respective switches, where the first messages are transmitted from the at least two switches over a signaling system 7 network to the presence server disposed in infrastructure of the PSTN. The presence server determines a presence state of a PSTN subscriber associated with at least one of the telephone lines based on the call event

information where the call event information defines both when the one telephone line is available and is not available to receive a call. A second message is transmitted over the Internet using Internet protocol to a first Internet terminal equipment of a first Internet user, the second message containing the presence state information associated with the at least one of the telephone lines.

Thus, in accordance with claim 1, presence state information about normal CPE supported by a switch in the PSTN is made available to an internet user via a presence server in the infrastructure of the PSTN that receives call event information over the SS7 network about the status of a CPE. This provides the ability to acquire the presence state of any CPE phone served by a PSTN switch at a remote internet site. Previously it is believed that presence state of a phone was limited to local phones directly connected to a PBX or specialized local server, or local phones connected to a LAN, such as described in Michael. The invention of claim 1 is not taught by Michael since it does not address this solution nor teach the recited limitations. The rejection of claim 1 under 35 U.S.C. §102 as being anticipated by Michael is requested to be withdrawn.

Independent claim 14:

Claim 14 is believed to be patentable for similar reasons explained above for claim 1. The rejection of claim 14 under 35 U.S.C. §102 as being anticipated by Michael is requested to be withdrawn.

Claim 19 (and 20):

Claim 19, which depends on claim 1, defines the step of receiving the first messages as comprising receiving the first messages by a service control point that is connected to the presence server disposed as part of the infrastructure of the PSTN, and the step of transmitting the second message comprises transmitting the second message by the presence server on every occurrence of the one telephone line changing from one presence state to another presence state.

In paragraph 10 of the Office Action it is alleged that Michael discloses a service control point. In the "Response to Arguments" section of the Office Action it is stated that a service control point is inherent. Applicant respectfully disagrees with both positions.

Paragraph 29 of Michael is cited for support. The phrase "service control point" is not present in that paragraph and hence it is clear that there is no explicit teaching of a service control point.

It is stated that "A service control point that is part of an intelligent node is inherent within an intelligent network." Since the premise of this statement is false, it does not support a correct conclusion. That is, one of ordinary skill in the art would understand that the phrase "intelligent node" does not itself require the usage of a service control point in it or with it. One of ordinary skill in the art would understand that a service control point's function is to identify and route SS7 messages as needed by other devices in the infrastructure of the telecommunication network.

Paragraph 29 of Michael states that the gateway 116, which could be a PBX or PSTN switch, "may be integrated with the multimedia server 104." This in fact teaches that there is no need for a service control point. One of ordinary skill in the art would understand that a first device that integrates the functionality of another device has no need for a service control point disposed internally within the integrated device, because any SS7 messages arriving at the integrated device would have no further need for being routed elsewhere as such messages have arrived at the destination device.

Referring to FIG. 5 of Michael, the presence server 215 is contained within the multimedia server 101; see paragraph 30 for the definition of these elements. If as proposed in the Office Action that a PSTN switch is integrated with the multimedia server, then such integration would be understood by one of ordinary skill in the art as meaning that there is no need for a service control point since any SS7 messages arriving at the integrated device would be at its destination and hence no further routing would be required. Thus, to suggest that such an integrated device would function as a service control point, whose function is to identify and route SS7 messages as needed by other devices, is technically illogical. Therefore, one of ordinary skill in the art would reject the explanation and grounds as advanced in paragraph 10 of the Office Action in

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considering the requirements of claim 19. The rejection of claim 19 under 35 U.S.C. 102 based on Michael is requested to be withdrawn. For the same reasons stated above, the rejection of claim 20 should also be withdrawn.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) MPEP 2112. (Emphasis added.)

In re Robertson addresses the issue of inherency. It is clear that extrinsic evidence must show that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. As explained above, one of ordinary skill in the art would not have found a service control point to be inherently/implicitly present in the structure as disclosed by Michael.

Claim Rejection - 35 U.S.C. §103:

Claims 1-7, 10, 12 and 14-17 were rejected under 35 U.S.C. §103 as being unpatentable over Tang in view of Michael. This rejection is respectfully traversed.

Claim 1 is allowable for similar reasons explained above regarding the rejection under 35 U.S.C.

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